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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/819,082      | 02/15/2001  | David McDaniel       | 509582000210        | 5783             |

7590

12/30/2005

Morrison & Foerster LLP  
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Suite 300  
McLean, VA 22102

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| EXAMINER |
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FARAH, AHMED M

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3735

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/819,082

Applicant(s)

David H. McDaniel

Examiner

Ahmed M. Farah

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) filed 02/15/2001 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Furthermore, this IDS fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper tames extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 7-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, and 10 of U.S. Patent No. 6,283,956 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to analogous methods of producing preferential damage to a hair exiting mammalian skin through a hair duct.

4. Claims 7-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, and 9 of copending Application No. 09/819,083. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to analogous methods for producing damage to hair duct and/or sebaceous oil gland.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Zaias et al U.S. Patent No. 5,647,866.

Zaias discloses a method for hair removal comprising the steps: of applying encapsulated augmentation compound to a region of tissue to cause the compound to accumulate within the dermis surrounding each hair follicle, providing a laser light capable of producing a wavelength matched to the absorption band of the said compound, and exposing the compound to the laser radiation. According to claims 2-4, Zaias indicates the preferred size/diameter of the compounds as presently claimed. See Zaias, Col. 5, lines 31-65. In this Office Action, the hair duct is treated as sebaceous gland.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zaias in view of Muller et al. U.S. Patent No. 4,836,203.

Zaias has been described above. However, Zaias does not teach the step of exposing the skin to an enzyme. Muller teaches that the absorption of laser photons by enzymes results a temperature gradient within a biological cell. Therefore, it would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to modify the Zaias's process and expose the skin to an enzyme, in order to increase the temperature of the augmentation compounds to cause damage to the hair follicle so that hair growth is prevented, and also to prevent the surrounding tissue from the thermal effect of the irradiated light.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zaias et al. in view of Tankovich et al., U.S. Patent No. 5,423,803.

Zaias has been described above. However, Zaias does not teach the step of exposing the skin to ultrasound. Tankovich et al., (U.S. Pat. No. 5,423,803) teaches the use of ultrasound. See Figs. 4 and 5 of Tankovich. Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify the method of Zaias and incorporate the use of ultrasound, in order to force some of the compounds below the surface layer of the skin being treated.

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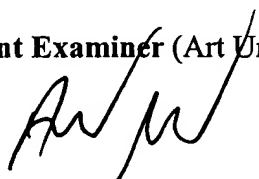
***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Nos. 6,050,990 and 5,817,089 to Tankovich et al., respectively, disclose methods and apparatus for inhibiting hair growth, the method comprising the steps: selecting an agent having an average diameter for enabling the agent to penetrate the hair duct; applying the agent to a skin section containing hair; and exposing the exposing the agent to an electromagnetic radiation, whereby the agent absorbs at least a first wavelength of the irradiation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703) 746-3368.

**A. M. Farah**

**Patent Examiner (Art Unit 3739)**

A handwritten signature in black ink, appearing to read 'A. M. Farah', is written over the printed name and title.

November 30, 2003